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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,970	12/08/2003	Kia Silverbrook	MTB07US	9050
24011	7590	12/28/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD			LEBRON, JANELLE M	
393 DARLING STREET				
BALMAIN, NSW 2041			ART UNIT	PAPER NUMBER
AUSTRALIA			2861	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/728,970	SILVERBROOK, KIA	
	Examiner Jannelle M. Lebron	Art Unit 2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 30 October 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-7, 13-19 and 25-31 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-7, 13-19 and 25-31 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 30 October 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 6, 7, 13, 18, 19, 25, 26, 30, and 31 are rejected under 35

U.S.C. 102(b) as being anticipated by Torpey (US Patent 5,801,727).

3. Torpey discloses:

- **Claim 1:**

an inkjet printhead (48 in figure 5; the examiner notes that the limitation "MEMS inkjet printhead" describes a process of manufacturing which is incidental to the claim apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, the process claim limitation is afforded no patentable weight (see MPEP 2113)) comprising a silicon substrate (col. 4, lines 25-30), having a plurality of nozzles, each nozzle comprising:

a chamber (16 in figure 2) adapted to contain an ejectable liquid (ink 21 in figure 2); and,

at least one droplet ejection actuator (80 in figure 5) associated with each of the chambers respectively, the droplet ejection actuator being adapted to eject a droplet of the ejectable liquid from the nozzle (column 4, lines 41-44), wherein,

the chambers are mounted on a passivation layer of the silicon substrate (col. 4, lines 25-30; the examiner notes that passivation layers are often made of silicon and thus the silicon substrate in the reference meets this limitation) and are at least partially formed by an amorphous ceramic material (column 3, lines 47-52).

- **Claim 2:**

wherein the drop ejection actuator (80 in figure 5) is a heater element configured for thermal contact with a bubble forming liquid within the chamber (column 4, lines 35-37); such that,

heating the heater element (80) to a temperature above the boiling point of the bubble forming liquid forms a gas bubble (92 in figure 5) that causes the ejection of a droplet of the ejectable liquid through the nozzle corresponding to that heater element (column 4, lines 41-44).

- **Claim 6:**

wherein the ejectable liquid is the same as the bubble forming liquid (column 4, lines 41-44).

- **Claim 7:**

wherein the printhead is a pagewidth printhead (column 4, lines 23-24).

- **Claim 13:**

a printer system which incorporates a inkjet printhead (48 in figure 5; the examiner notes that the limitation “MEMS inkjet” describes a process of manufacturing which is incidental to the claim apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, the process

claim limitation is afforded no patentable weight (see MPEP 2113)), the printhead comprising a silicon substrate (col. 4, lines 25-30), each nozzle comprising:

a bubble forming chamber (16 in figure 2) adapted to contain a bubble forming liquid (ink 21 in figure 2); and,

at least one heater element (80 in figure 5) disposed in each of the bubble forming chambers respectively, the heater elements configured for thermal contact with the bubble forming liquid (as seen in figure 5); such that,

heating the heater element (80) to a temperature above the boiling point of the bubble forming liquid forms a gas bubble (92 in figure 5) that causes the ejection of a drop of an ejectable liquid from the nozzle corresponding to that heater element (column 4, lines 41-44),

wherein the bubble forming chambers are mounted on a passivation layer of the silicon substrate (col. 4, lines 25-30; the examiner notes that passivation layers are often made of silicon and thus the silicon substrate in the reference meets this limitation) and are at least partially formed by an amorphous ceramic material (column 3, lines 47-52).

- **Claim 18:**

wherein the ejectable liquid is the same as the bubble forming liquid (column 4, lines 41-44).

- **Claim 19:**

wherein the printhead is a pagewidth printhead (column 4, lines 23-24).

- **Claim 25:**

a method of ejecting drops of an ejectable liquid from a MEMS inkjet printhead

(48 in figure 5; the examiner notes that the limitation "MEMS inkjet" describes a process of manufacturing which is incidental to the claim apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation.

Consequently, the process claim limitation is afforded no patentable weight (see MPEP 2113)), the printhead comprising a silicon substrate (col. 4, lines 25-30) having a plurality of nozzles (64 in figure 5), each nozzle comprising:

a chamber (16 in figure 2) corresponding to each of the nozzles respectively (column 4, lines 25-27), the chambers adapted to contain an ejectable liquid (ink 21 in figure 2); and,

at least one droplet ejection actuator (80 in figure 5) associated with each of the chambers respectively,

wherein the chambers are mounted on a passivation layer of the silicon substrate (col. 4, lines 25-30; the examiner notes that passivation layers are often made of silicon and thus the silicon substrate in the reference meets this limitation) and are at least partially formed by an amorphous ceramic material (column 3, lines 47-52);

the method comprising the steps of:

placing the ejectable liquid into contact with the drop ejection actuator; and
actuating the droplet ejection actuator such that a droplet of an ejectable liquid is ejected from the corresponding nozzle (column 4, lines 41-44).

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- **Claim 26:**

wherein the drop ejection actuator (80 in figure 5) is a heater element configured for thermal contact with a bubble forming liquid within the chamber (column 4, lines 35-37); such that,

heating the heater element (80) to a temperature above the boiling point of the bubble forming liquid forms a gas bubble that causes the ejection of a droplet of the ejectable liquid through the nozzle corresponding to that heater element (column 4, lines 41-44).

- **Claim 30:**

wherein the ejectable liquid is the same as the bubble forming liquid (column 4, lines 41-44).

- **Claim 31:**

wherein the printhead is a pagewidth printhead (column 4, lines 23-24).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 3-5, 15-17, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torpey (US Patent 5,801,727).

6. Torpey discloses substantially the claimed invention except for "wherein the amorphous ceramic material is silicon nitride", "wherein the amorphous ceramic material is silicon dioxide", and "wherein the amorphous ceramic material is silicon oxynitride." It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design preference. *In re Leshin*, 125 USPQ 416. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use these types of ceramics as the preferred material in order to lower cost and increase the durability of the printhead by using these well-known wear resistant materials to manufacture the chambers.

Communication with the USPTO

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jannelle M. Lebron whose telephone number is (571) 272-2729. The examiner can normally be reached on Monday thru Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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AU 2861
12/19/2006



STEPHEN MEIER
SUPERVISORY PATENT EXAMINER